

REMARKS

**A. Summary of Claim Status.** Claims 1-13 and 15-21 are pending in the Application and have been examined. Claim 14 has been canceled. Claims 22 and 23 are added hereby. Of the previously pending Claims, Claims 2, 4, 6, 8, 10, and 12 are allowed, and Claims 5, 7, 9, 11, 16, 17, 20 and 21 are indicated to be allowable, excepting that they depend from a previously rejected independent Claim. Claims 1, 3, 13, 15, 18 and 19 stand rejected.

Claim 18 is amended hereby to correct a typographical error. No other claims amendments are presented.

Claim 19 was previously indicated to be allowable. Claim 19 depends from allowable, but objected to, Claim 16. Therefore, Claim 19 is believed to be allowable.

Claims 22 and 23 are added hereby. Support for these Claims is found in Figures 5 and 6.

**B. Summary of Prior Art Rejections.** Independent Claim 1 and independent Claim 13 have been rejected under 35 USC §103(a) as being unpatentable over Goldhaber, U.S. Patent No. 3,978,614 in view of Diemunsch, et al., U.S. Patent No. 5,098,790. Goldhaber is directed to a window casement covering that includes a plane of material and a stile. Goldhaber does not teach a sandwich material that is formed from two or more planes of material. Diemunsch, et al. is cited as teaching a first plane of material, a second plane of

material, and a core disposed there between, wherein the core material is polycarbonate.

**C. Summary of Requirements for an Obviousness Rejection.**

“(R)ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.” *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed.Cir.1998).

“Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’” *In re Rouffet*, *supra*, citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). The use of hindsight in the selection of references to create an obviousness rejection is forbidden. *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed.Cir.1991); *In re Rouffet*, *supra*. An examiner is required to show a motivation to combine the references that create the case of obviousness. The examiner must show reasons why the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. No *prima facie* case of obviousness is present where the examiner fails to explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the claimed invention to make the combination. *In re Rouffet*, *supra*.

SEE also MPEP § 2143.01.

**D. Argument Regarding the Obviousness Rejections.** The combination of Goldhaber, in view of Diemunsch, et al., does not meet the limitations of Claims 1 and 13. Claims 1 and 13 require that “at least one stile holds said first plane of material, said second plane of material and said core in position to form said sandwich material.” The stile of Goldhaber does not hold multiple planes of material together. Diemunsch, et al. does not teach a stile, and therefore, does not teach a stile that holds multiple planes together. The combination fails to teach that multiple planes of material are held together by a stile to form a sandwich material as required by Claims 1 and 13.

Diemunsch, et al. teaches a panel. There is no teaching or suggestion in Diemunsch, et al. that the panel may be used to form a window covering or shutter. The Official Action fails to show reasons why the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the teachings of Diemunsch, et al. for combination with Goldhaber to arrive at the invention as claimed in Claims 1 and 13. The Official Action also fails to explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the claimed invention to make the combination. Accordingly, the Official Action fails to set forth a proper rejection under 35 USC §103. Goldhaber does not teach a multiple layer window covering. Diemunsch, et al. do not teach a window covering at all, nor do they teach that their multiple layers will provide superior protection against missiles or projectiles. There is no motivation found in the references for one skilled in the art to employ multiple

layers as a window covering in order to solve the problem of protecting a window from wind driven missiles, according to the structure required by Claims 1 and 13. Since there is no motivation or suggestion found in the references to use multiple layers as a window covering, there can be no motivation or suggestion to combine the references. Further, the references do not teach or suggest that multiple layers with polycarbonate used as a core will lead to superior protection of windows from missiles or projectiles. These references cannot be combined to create a rejection of the Claims under 35 USC §103.

**E. Newly Added Claims.** Claims 22 and 23 are added by way of amendment. These Claims require that the first plane of material have a reduced dimension along an edge of a surface. The stile is adjacent to the first plane of material, which allows the stile to be flush with the surface of the first plane of material, as shown in Figures 5 & 6. Goldhaber does not teach a first plane of material of reduced dimension, and the stile is not flush with the surface of a portion of the plane of material as required by Claims 22 and 23.

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It is respectfully submitted that Claims 1-13, and 15-21, are in condition for allowance. Review and allowance at the earliest possible date is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. Craig Killough', is written over a horizontal line.

B. Craig Killough  
Attorney for Applicant  
Registration Number 30,398  
P.O. Drawer H  
Charleston, SC 29402  
(843) 577-7700

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